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		First Named Inventor	Brian Bodmer
		Art Unit	3625
		Examiner Name	Shah, Amee A
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Complete if Known

Application Number	09/920,592
Filing Date	July 31, 2001
First Named Inventor	Brian Bodmer
Examiner Name	Shah, Ameer A
Art Unit	3625
Attorney Docket No.	6783P023

☐ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT (\$)
500.00

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ None ☐ Other (please identify):

☐ Deposit Account Deposit Account Number: 02-2666 Deposit Account Name: Blakely, Sokoloff, Taylor & Zafman LLP

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FEE CALCULATION

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
2053	130	2053	130	Non-English specification	
1251	120	2251	60	Extension for reply within first month	
1252	450	2252	225	Extension for reply within second month	
1253	1,020	2253	510	Extension for reply within third month	
1254	1,590	2254	795	Extension for reply within fourth month	
1255	2,160	2255	1,080	Extension for reply within fifth month	
1401	500	2401	250	Notice of Appeal	
1402	500	2402	250	Filing a brief in support of an appeal	500.00
1403	1,000	2403	500	Request for oral hearing	
1451	1,510	2451	1,510	Petition to institute a public use proceeding	
1460	130	2460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
1809	790	1809	395	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))	
Other fee (specify)					
SUBTOTAL (2)				(\$)	500.00

SUBMITTED BY

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Brian Bodmer et al.

Application No: 09/920,592

Filing Date: July 31, 2001

For: INTEGRATED SHOPPING CART
FOR SALE OF THIRD PARTY
PRODUCTS AND SERVICES VIA
THE INTERNET

Examiner: Amee A. Shah

Art Unit: 3625

Confirm. No.: 5999

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37(a)

This is an appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner of Group 3625, dated May 3, 2006, which finally rejected claims 1-19, 58-61, 64-67, and 73-39 in the above-identified application. This Appeal Brief is hereby submitted pursuant to 37 C.F.R. § 41.37(a).

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I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the full interest in the invention, LightSurf Technologies, Inc., a California corporation, located at 110 Cooper Street, 4th Floor, Santa Cruz, CA 95060, a wholly owned subsidiary of Verisign, Inc. a Delaware corporation, located at 487 East Middlefield Road, Mountain View, CA 94043.

II. RELATED APPEALS AND INTERFERENCES

To the best of Appellants' knowledge, there are no appeals or interferences related to the present appeal that will directly affect, be directly affected by, or have a bearing on the Board's decision in the instant appeal.

III. STATUS OF THE CLAIMS

Claims 1-19 and 58-79 are pending in the application. Claims 20-57 have been cancelled or withdrawn previously. Claims 62, 63, and 68-72 were cancelled from consideration in an Office Action mailed May 3, 2006, and claims 1-19, 58-61, 64-67, and 73-79 were finally rejected in the Office Action mailed May 3, 2006. Claims 1-19, 58-61, 64-67, and 73-79 are the subject of this appeal. A copy of Claims 1-19, 58-61, 64-67, and 73-79 as they stand on appeal are set forth in Claims Appendix (A).

IV. STATUS OF AMENDMENTS

An amendment was submitted by Appellants on June 30, 2006 and was refused entry by the Examiner in the Advisory Action of July 17, 2006. Appellants note that the amendment would have changed only a few words and removed matter which the

Examiner argued was new and/or previously restricted matter. Furthermore, the Appellants contend that the amendment would have placed the claims in a better form for appeal. Appellants have submitted as Claims Appendix (A) the claims 1-19, 58-61, 64-67, and 73-79 as of the Final Rejection of December 27, 2005. The Appellants have also submitted the claims 1-19, 58-61, 64-67, and 73-79 as Claims Appendix (B) in the form they would be if the proposed amendment of June 30, 2006 was entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Appellants' invention as claimed in claims 1-19 and 58-79 is directed to a system that enables an e-commerce retailer to display, sell, and arrange fulfillment of orders for items of third party vendors through the e-commerce retailer's own internet site. This system seamlessly presents items of the e-commerce retailer with third party supplier items to users for on-line commerce (Specification, page 10, line 2 to page 13, line 2; page 18, lines 22-25).

Independent claim 1, and dependent claims 2-19 that depend from independent claim 1, claims a method for an e-commerce retailer to display and sell items of a third party, including: identifying one or more items of a third party with a unique identifier (Specification, page 10, line 7-17; page 11, lines 6-25; Figure 3;); associating the unique identifier of the item with an image of the item, said image residing on a computer maintained by the third party (Specification, page 19, lines 6-16; Figure 3); presenting at least some of the images of third party items to a user for on-line commerce, said images being retrieved from said computer maintained by the third party (Specification, page 19, lines 6-16; page 24, line 19 to page 25, line 26; Figures 3

and 4); in response to an order request from the user for one or more items, identifying, based at least in part on said unique identifier, each item requested and an appropriate third party for each requested item (Specification, page 25, line 11 to page 26, line 18; Figures 4); and automatically generating an order for each request item to be transparently sent to the third party (Specification, page 11, line 26 to page 12, line 7, page 25, line 11 to page 26, line 18; Figures 4).

Dependent claim 12 further claims a given third party provides Uniform Resource Locators (URLs) for images in various sizes and formats (Specification, page 25, lines 19-26). The URLs for images in various sizes and formats thus enable the retrieval and display of images to the user in various sizes and formats (Specification, page 22, lines 9-19; page 25, lines 19-26; Figure 4).

Independent claim 58 and dependent claims 59-66, which depend from claim 58, claim the invention as a system. Independent claim 67 and dependent claims 68-75, which depend from claim 67, claim the invention as a system.

Independent claim 76 and dependent claims 77-79, which depend from claim 76, claim the invention as a system. Additionally independent claim 76 includes an extensible markup language (XML) request logic to retrieve the data about the one or more items from a third party supplier website (Specification, page 32, line 6 to page 34, line 37; Figure 4); the XML request logic enables an e-commerce logic to present the data to the user for the on-line commerce (Specification, page 23, line 11 to page 24, line 17; page 24, line 19 to page 27, line 2)

VI. GROUNDS OF REJECTIONS TO BE REVIEWED ON APPEAL

- A. Whether claims 1-19, 58-61, 64-67, and 73-79 are patentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,017, 157 of Garfinkle et al. (hereinafter "Garfinkle") in view of U.S. Patent Application No. 2004/0138962 A1 of Kopelman et al. (hereinafter "Kopelman")?
- B. Whether Garfinkle, Kopelman, and U.S. Patent Pub. No. 2002/0065741 A1 of Baum (hereinafter "Baum") render obvious, under 35 U.S.C. § 103(a), "A Given Third Party Provides Uniform Resource Locators (URLs) for Images in Various Sizes and Formats, Thereby Enabling Retrieval and Display of Images to the User in Various Sizes and Formats?"

VII. ARGUMENT

Appellants submitted an amendment in the Amendment and Response of June 30, 2006 that was denied entry in the Advisory Action of July 17, 2006. As noted previously, Appellants have included copies of both the claims as finally rejected and the claims as amended. However, Appellants submit that the changes in the claims as amended do not materially affect the patentability of the claims in light of the references cited by the Examiner, and therefore only submit one set of arguments.

A. Claims 1-19, 58-61, 64-67, and 73-79 are patentable over Garfinkle in view of Kopelman.

1. Claim Group I: Claims 1-19, 58-61, 64-67, and 73-79. Appellant's Invention is Patentable Over the Combination of Garfinkle and Kopelman.

The Examiner has rejected claims 1-4, 7, 8, 11, 13, 16, 58-61, 67, and 76-79 under 35 U.S.C. § 103(a) over Garfinkle in view of Kopelman. As discussed above, Appellants' invention as claimed is directed to a system that enables an e-commerce retailer to seamlessly display, sell, and arrange fulfillment of orders for items of third party vendors through the e-commerce retailer's own internet site.

Garfinkle describes a method for processing print and digital images of a photographer (Garfinkle, Abstract; Column 1, line 59 to Column 2, line 4). Print photographs are scanned from a roll of film and corresponding digital images are transferred/uploaded to a server by a photographer (Garfinkle, Column 2, lines 43-64). An access code is described that identifies the photographer's digital images, as well as a particular image server where the images are stored (Garfinkle, Column 4, lines 6-20). The photographer may then order print copies of the uploaded digital images from a pre-selected fulfillment center utilizing the photographer's access code (Garfinkle, Column 9, lines 8-13; Column 9, lines 26-41).

Kopelman describes a method and apparatus for pricing used goods of independent sellers (Kopelman, Abstract). When a seller wishes to sell an item in a virtual marketplace, the seller registers the item with a marketer (e.g., the marketplace website) (Kopelman, Figure 2; paragraphs 0035-0036). The seller registers the item by entering a standard UPC or ISBN number for the item at the virtual marketplace

(Kopelman, paragraph 0035). The registration associates the standard commercial code for the item with a record for the seller (Kopelman, paragraph 0035). The virtual marketplace then generates an index price for the seller's registered item that is adjusted to reflect a value for the item (Kopelman, paragraph 0036). Furthermore, the seller need not be identified by the virtual marketplace before a sale (Kopelman, Figure 1). When a buyer does decide to purchase an item from a seller, the virtual marketplace either introduces the buyer and seller so they can complete the sale directly, redirects each party to a clearinghouse, or acts as the clearinghouse (Kopelman, paragraph 0030).

a. *Claims 1-19, 58-61, 64-67, and 73-79 Are Patentable Over the Combination of Garfinkle and Kopelman*

"To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest all the claim limitations" (MPEP 706.02(j); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). The Appellants respectfully submit that Garfinkle and Kopelman, when considered alone or in combination, fail to disclose or suggest the invention as claimed by the Appellants.

Claim 1 recites:

 An improved method for an e-commerce retailer to display and sell items of a third party comprising:

 identifying one or more items of a third party with a unique identifier;

 associating the unique identifier of the item with an image of the item, said image residing on a computer maintained by the third party;

 presenting at least some of the images of third party items to a user for on-line commerce, without indicating the items are third party items, said images being retrieved from said computer maintained by the third party;

in response to an order request from the user for one or more items, identifying, based at least in part on said unique identifier, each item requested and an appropriate third party for each requested item; automatically generating an order for each requested item to be transparently sent to the third party.

As discussed above, Garfinkle describes a system that associates an identifier with a photographer's images (Garfinkle, Column 4, lines 6-20). The photographer then uses the identifier *associated with his images* to order copies of those images from a pre-selected fulfiller (Garfinkle, Column 9, lines 1-13). Therefore, the identifier described by Garfinkle identifies the photographer's digital images and is associated with the photographer's digital images, but not items of a third party fulfiller.

The Examiner asserts on page 6 of the Final Office Action that Garfinkle teaches "identifying one or more items of a third party with a unique identifier (Fig. 4 and col. 4, lines 6-20 – note the unique identifier is the access code, the item is a digital image and the third party is the photographer)" (Final Office Action, May 3, 2006, page 6, paragraph 3). The Examiner then asserted that "presenting at least some of the images of third party items [i.e., the photographer's digital images] to a user for on-line commerce ... said images being retrieved from said computer maintained by the third party" and noting that "the retrieval of images is using the upload interface to transfer data" (Final Office Action, mailed May 3, 2006, page 6). The Appellants respectfully disagree.

Garfinkle explicitly teaches that orders for image prints are placed by the photographer (Garfinkle, column 7, lines 43-52). Therefore, according to the Examiner's assertions, that when "in response to an order request ... automatically generating an order for each requested item to be transparently sent to the third party,"

the photographer would place an order for his own photographs with himself. It does not make logical sense for the photographer of Garfinkle to place an order with himself for his photographs.

Furthermore, the Appellants, claim a system with three distinct actors. The user, as claimed in claim 1, is distinct from the third party, which are both distinct from the e-commerce retailer. That is a user places an order with an e-commerce retailer, which generates an order that is automatically sent to a third party. Since the photographer of Garfinkle is explicitly interpreted by the Examiner as the third party, the photographer cannot also be the user. Therefore, the Examiner's interpretation of Garfinkle could not teach or suggest the limitations as asserted by the Examiner (Final Office Action, May 3, 2006, page 6) because such an interpretation would not cover each and every element as claimed by the Appellants.

Consequently, either Garfinkle fails to describe or suggest "identifying one or more items of a third party supplier with a unique identifier" since Garfinkle utilizes an identifier associated with a photographer's images, and not a third party, or Garfinkle fails to describe or suggest "presenting at least some of the images of third party items to a user for on-line commerce, without indicating the items are third party items" because the photographer is the third party, and thus not the user.

Although the Examiner does not assert that Kopelman describes the limitation discussed above, the Appellants respectfully submit that Kopelman also fails to teach or suggest "identifying one or more items of a third party supplier with a unique identifier." Rather, Kopelman describes that merchandise of a seller may be identifiable by a standard UPC or ISBN code (Kopelman, paragraph 0035). Such a standard UPC or

ISBN code is not a unique identifier for third party items as described in the Appellants' specification, since all identical items receive the same UPC/ISBN code, and thus the codes are not unique. Furthermore, the standard codes (i.e., UPC or ISBN) are then associated with a record for the seller, but not the seller's items.

The invention of claim 1 further states that "in response to an order request from the user for one or more items ... automatically generating an order for each requested item to be transparently sent to the third party." As described by the Appellants:

When the customer finishes shopping and proceeds to check out and purchase the items selected, the system of the present invention automatically determines which items are available in inventory and which items are to be supplied by third parties. For the items to be fulfilled by a third party, the retailer determines the supplier of the products and sends the order for the product to the supplier in the manner described below. [¶] This order for third party products is routed by the retailer, again using XML, to the order engine in a manner that is transparent to the customer. (Specification, Page 11, Line 26 to Page 12, Line 7).

As such, the determination as to which fulfiller will supply a customer's order is not made by the customer, but rather generated in a manner transparent to the customer.

The Examiner asserts that the noted limitation is taught by Garfinkle (Final Office Action, mailed May 3, 2006, page 6) where Garfinkle describes that orders placed by a photographer are received and fulfilled at a fulfillment centers (Garfinkle, Column 9, Lines 14-25). However, Garfinkle explicitly recites:

When the photographer 8 uploads one or more digital images directly to the image server 16, these images are either added to a set of images already associated with an access code or the new images are assigned a new unique access code. When a new access code is assigned, a price sheet must be associated with these images in order to provide to the photographer 8 the visual prints which may be ordered using the new

images. In a preferred embodiment, the photographer 8 selects a fulfillment center 20 which they prefer to use to fulfill all orders placed using the new images. A price sheet is associated with each fulfillment center 20, and this price sheet forms the basis for the products available to the photographer 8, and the prices of these products. [Emphasis Added] (Garfinkle, Column 9, Lines 1-13).

Therefore, the photographer must select a fulfiller prior to placing orders for products available from a given supplier, and thus must take affirmative steps to complete fulfillment of an order. However, requiring that a photographer take steps to identify and select a fulfiller fails to describe generating an order that is transparent. In contrast, the Appellants claim a method that removes the choice of fulfiller/supplier from the customer as to which fulfiller will fulfill a specific order. Because Garfinkle Explicitly teaches that prior to placing an order for fulfillment, a photographer must select a particular fulfiller, Garfinkle specifically teaches away from “automatically generating an order for each requested item to be transparently sent to the third party.”

Furthermore, as described above, Kopelman facilitates the sale of fungible goods utilizing an index price. Although the seller of a particular item need not be identified to the buyer, in order to place an order for the item, Kopelman either introduces the buyer and seller so they can complete the sale directly, redirects each party to a clearinghouse, or acts as the clearinghouse to complete the transaction (Kopelman, paragraph 0030). As such, Kopelman requires further actions of the buyer and seller when placing an order for an item. Thus, Kopelman also fails to teach or suggest “automatically generating an order for each requested item to be transparently sent to the third party.”

Because neither reference, alone or in combination, teaches or suggests the elements as claimed by the Applicants in claim 1, the Applicants submit that Garfinkle in view of Kopelman fails to render claim 1 obvious. Since claims 2-4, 7, 8, 11, 13, and 16 depend from claim 1, and add additional features and limitations, claims 2-4, 7, 8, 11, 13, and 16 are also not rendered obvious by Garfinkle in view of Kopelman. The Applicants respectfully request withdrawal of the rejections.

Claim 58 similarly claims:

A system providing an improved method for an e-commerce retailer to display and sell items of a third party, said system comprising:
an e-commerce retailer to identify an item of a third party supplier with a unique identifier;
an image server module for receiving user information requests from the e-commerce retailer regarding certain third party supplier items, and transparently providing images and descriptions of said items; and
an order engine module, in communication with said image server module, for processing orders for third party supplier items.

As discussed above, with respect to claim 1, neither Garfinkle nor Kopelman, alone or in combination teach or suggest identifying and selling third party items with a unique identifier in a transparent manner to a user through an e-commerce retailer. Therefore, for similar reasons to those discussed above with respect to claim 1, Garfinkle and Kopelman, alone or in combination, also fail to render claim 58 obvious. Furthermore, claims 59-61 depend on claim 58, and include additional features and limitations. Thus, claims 59-61 are also not rendered obvious under Garfinkle in view of Kopelman.

Claim 67, as amended, claims:

An improved e-commerce system for providing products and services of third parties, said system comprising:
a computer implemented program logic to transparently present third party supplier items to a user for on-line commerce;

computer-implemented program logic for receiving user information requests regarding certain graphic images from an item presentation program logic, and providing digital images for display; and computer-implemented program logic for processing orders for graphic images to be transparently sent to the appropriate third party supplier.

As discussed above, with respect to claim 1, neither Garfinkle nor Kopelman, alone or in combination teach or suggest identifying and selling third party items in a transparent manner to a user through an e-commerce retailer. Therefore, similarly to the reasons discussed above with respect to claim 1, Garfinkle and Kopelman, alone or in combination, also fail to render claim 67 obvious.

Claim 76 claims:

A system comprising:
a tagging logic to identify one or more items of a third party supplier with unique identifiers, each unique identifier associated with data about that item;
an e-commerce logic to transparently present at least some of the items to a user for on-line commerce;
an XML request logic to retrieve the data about the one or more items from a third party supplier website, and enabling the e-commerce logic to present the data to the user for the on-line commerce; and
an order engine to process orders for items.

As discussed above, with respect to claim 1, neither Garfinkle nor Kopelman, alone or in combination teach or suggest identifying and selling third party items in a transparent manner to a user through an e-commerce retailer. Therefore, similarly to the reasons discussed above with respect to claim 1, Garfinkle and Kopelman, alone or in combination, also fail to render claim 76 obvious. Furthermore, claims 77-79 depend on claim 76, and include additional features and limitations. Thus, claims 77-79 are also not rendered obvious under Garfinkle in view of Kopelman.

***b. Claim Group II: Claims 76-79. Appellant's Invention is Patentable
Over the Combination of Garfinkle in view Kopelman.***

The Examiner rejected claims 76-79 stating "all limitations in apparatus claims ... 76-79 are closely parallel to the limitations of method claims 1-4 ... and are rejected on the same basis" (Final Office Action, mailed May 3, 2006, page 9, second paragraph).

The Appellants respectfully disagree and submit that the Examiner has failed to address the specific limitations as claimed by the Appellants in claims 76-79.

Claim 76 recites:

A system comprising:
a tagging logic to identify one or more items of a third party with unique identifiers, each unique identifier associated with data about that item;
an e-commerce logic to transparently present at least some of the items to a user for on-line commerce;
an XML request logic to retrieve the data about the one or more items from a third party website, and enabling the e-commerce logic to present the data to the user for the on-line commerce; and
an order engine to process orders for items.

In particular, the system claimed in claim 76 is configured to utilize an extensible markup language (XML) request logic in the retrieval and supply of data for an e-commerce system, such as the system of claim 76 (Appellants' Specification, page 23, line 11 to page 24, line 17; page 24, line 19 to page 27, line 2).

The Appellants are unable to find any reference within Garfinkle or Kopelman that teaches or suggests the utilization of an XML request logic in the methods and systems described by Garfinkle and Kopelman. Rather, Garfinkle describes a UNIX based system that utilizes a RAID-based file database (See Garfinkle, column 5, line 36 to column 6, line 55). Kopelman is similarly silent as to the utilization of an XML request

logic, but instead describes the standard web browsers interfacing over a communications network without further suggesting any specific implementations (See Kopelman, page 3, paragraph [0033]).

Therefore, in addition to the reasons discussed above in section A(1) and A(2) of the Appellants' Appeal Brief, since neither reference, alone or in combination, teaches or suggests a system configured to utilize an XML request logic, claim 76 is not rendered obvious by Garfinkle in view of Kopelman. Furthermore, dependent claims 77-79 depend on claim 76, and include additional features and limitations. Thus, claims 77-79 are also not obvious under Garfinkle in view of Kopelman.

B. Claim 12 is not Obvious Over Garfinkle, Kopelman, and U.S. Patent Pub. No. 2002/0065741 A1 of Baum (hereinafter "Baum").

Appellant respectfully submits that Garfinkle, Kopelman, and Baum, alone or in combination, fail to teach or suggest each and every limitation as claimed. The reasons cited above with respect to independent claims 1 are applicable to claim 12, and are herein incorporated by reference.

Baum does not solve the shortcoming of Garfinkle and Kopelman described above, regarding providing third party items with unique identifiers.

Furthermore, claim 12 includes the additional limitation of "a given third party provides Uniform Resource Locators (URLs) for images in various sizes and formats, thereby enabling retrieval and display of images to the user in various sizes and formats." In other words, when presenting images of third party items, retrieved from a computer maintained by the third party, to a user, URLs for various image sizes and

formats are supplied to the user. (Specification, page 25, lines 19-26). Although the Examiner only relied on Baum to reject claim 12, the Appellants respectfully submit that the above limitations are absent from Garfinkle and Kopelman.

The Examiner admitted that Garfinkle and Kopelman do not teach that “a given third party provides Uniform Resource Locators (URLs) for images in various sizes and formats, thereby enabling retrieval and display of images to the user in various sizes and formats” (Final Office Action, mailed May 3, 2006, page 9, paragraph 4). However, the Examiner argued that Baum discloses “a method for distributing images to multiple recipients including wherein the images of items include descriptive text (Baum, Fig. 5 and page 8, ¶0080 – note the descriptive text is the number for the images)” (Final Office Action, mailed May 3, 2006, page 9, paragraph 4). The Appellants respectfully disagree.

Baum describes an e-postcard and image distribution system. In particular, Figure 5 illustrates “an exemplary graphical user interface (GUI) based environment that employs iconographic aliases (graphical representations of distribution groups) and graphical input techniques to enable a user to designate intended recipients of digital images and/or prints of the digital images” (Baum, paragraph 80). When a user desires to access pictures, the user enters a URL supplied by a photofinisher where the user’s images are currently being hosted (Baum, paragraphs [0080]-[0082]). The images may then be distributed by the user to various iconographic distribution aliases by simply designating who is included in an alias (Baum, paragraph [0080]).

Baum and the Examiner, however, are completely silent as to “a given third party provides Uniform Resource Locators (URLs) for images in various sizes and formats,

thereby enabling retrieval and display of images to the user in various sizes and formats.” Baum fails to describe whether or not the sizes and formats of the images, which are provided by a third party via a URL, are provided by the third party in various formats and/or various sizes. Furthermore, when the user described by Baum utilizes the photofinisher-supplied URL to access their images, Baum is completely silent as to the photo-finisher providing links to the images in various sizes and/or formats and whether a user is enabled to retrieve the various sizes and formats. In fact, Baum explicitly states that a photofinisher supplies “a uniform resource locator (URL) address” (Baum, paragraph [0080]). At best, Baum may merely provide for a party supplying a single URL to a webpage hosting images, without discussing multiple URLs, images of various sizes, and images of various formats. Thus, Baum fails to describe, or even suggest, the noted limitation.

In addition to the reasons applied to its respective base claim, claim 12 is independently patentable over Garfinkle, Kopelman, and Baum. Therefore, the Appellant respectfully submits that Garfinkle, Kopelman, and Baum do not render obvious claim 12.

VIII. CONCLUSION

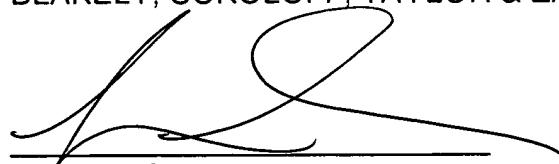
Appellants contend that all claims are in condition for allowance. Appellants contend that the claims are patentable in light of the combination of Garfinkle and Kopelman, and further in light of Garfinkle, Kopelman, and Baum. Therefore, Appellants respectfully submit that the references alone or in combination do not teach,

disclose, or make obvious Appellants' claimed invention. Appellants respectfully pray for reversal of the Examiner's rejection.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Appellants hereby request such extension.

Respectfully submitted,
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Dated: October 3, 2006



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CLAIMS APPENDIX (A)

FOR APPEAL BRIEF UNDER 37 C.F.R. § 41.37(c)(1)(viii)

Claims 1-19, 58-61, 64-67, and 73-39 are the subject of this appeal. A copy of Claims 1-19, 58-61, 64-67, and 73-39, as they stand on appeal, are presented below.

1. (Previously Presented) An improved method for an e-commerce retailer to display and sell items of a third party comprising:
 - identifying one or more items of a third party with a unique identifier;
 - associating the unique identifier of the item with an image of the item, said image residing on a computer maintained by the third party;
 - presenting at least some of the images of third party items to a user for on-line commerce, without indicating the items are third party items, said images being retrieved from said computer maintained by the third party;
 - in response to an order request from the user for one or more items, identifying, based at least in part on said unique identifier, each item requested and an appropriate third party for each requested item;
 - automatically generating an order for each requested item to be transparently sent to the third party.

2. (Original) The method of claim 1, wherein the items include products.

3. (Original) The method of claim 1, wherein the items include services.

4. (Original) The method of claim 1, wherein the images of items include graphic images.

5. (Original) The method of claim 1, wherein the images of items include descriptive text.

6. (Original) The method of claim 1, wherein a given unique identifier references a corresponding product Stock Keeping Unit (SKU) numbers.

7. (Original) The method of claim 1, wherein a given unique identifier references pricing information from a third party.

8. (Original) The method of claim 1, wherein a given unique identifier references order fulfillment information.

9. (Original) The method of claim 1, wherein said step of presenting includes:
requesting images from a third party;
receiving a list of Uniform Resource Locators (URLs) for said requested images;
and
displaying an on-line page that displays images retrieved from said URLs.

10. (Currently Amended) The method of claim 9 1, wherein the request for images includes background and formatting information of a particular third party.

11. (Original) The method of claim 1, wherein a particular third party provides photo-finishing services and the images correspond to user photographic images.

12. (Original) The method of claim 1, wherein a given third party provides Uniform Resource Locators (URLs) for images in various sizes and formats, thereby enabling retrieval and display of images to the user in various sizes and formats.

13. (Original) The method of claim 1, wherein a given third party initially provides smaller thumbnail images of the items and provides larger images in response to user requests.

14. (Original) The method of claim 1, wherein a given third party evaluates the request for images or descriptions and automatically indicates whether corresponding items are available.

15. (Original) The method of claim 1, wherein the unique identifier associated with a given item is stored in a user's shopping cart when the user selects the item.

16. (Original) The method of claim 1, wherein the images are rendered on a Web page for display to the user.

17. (Original) The method of claim 1, wherein the unique identifier of an item requested by the user is employed for placing a fulfillment request with a corresponding third party.

18. (Original) The method of claim 1, further comprising:
automatically splitting an order including individual order items from more than one third party; and
assigning fulfillment of individual order items to the appropriate third parties.

19. (Original) The method of claim 1, wherein an order including items from the retailer and items from one or more third parties is split amongst the retailer and the appropriate third parties.

20. – 29. (Cancelled)

30. (Withdrawn) A system providing an improved method for an e-commerce retailer to display and sell items of a third party, said system comprising:

an e-commerce retailer to identify an item of a third party with a unique identifier;
an image server module for receiving information requests from the e-commerce retailer regarding certain items, and providing images and descriptions of said items;
an order engine module, in communication with said image server module, for processing orders for items; and
a fulfillment module, in communication with said order engine module, for automating fulfillment of pending orders from one or more third party fulfillers.

31. (Withdrawn) The system of claim 30, wherein the items include products.

32. (Withdrawn) The system of claim 30, wherein the items include services.

33. (Withdrawn) The system of claim 30, wherein the items include graphic images corresponding to photo-finishing services offered to a user, at least some graphic images being based on photographs previously taken by the user.

34. (Withdrawn) The system of claim 30, wherein the order engine module automatically validates each order.

35. (Withdrawn) The system of claim 30, wherein the order engine module automatically checks availability of each item.

36. (Withdrawn) The system of claim 30, wherein the order engine module automatically determines an appropriate fulfiller for each item.

37. (Withdrawn) The system of claim 30, wherein the order engine module: automatically splits an order among more than one third party fulfiller; and automatically assigns fulfillment of individual order items to one or more appropriate third party fulfillers.

38. (Withdrawn) The system of claim 30, wherein the order engine module splits orders including items from the retailer and items from one or more third parties fulfillers amongst the retailer and appropriate third party fulfillers.

39. (Withdrawn) The system of claim 30, wherein the fulfillment module automatically routes an order for each item to be supplied by a third party fulfiller to an appropriate third party fulfiller.

40. (Withdrawn) The system of claim 30, wherein the fulfillment module automatically requests a status update regarding each order item from a corresponding third party fulfiller that has been selected to fulfill such order item.

41. (Withdrawn) The system of claim 30, wherein the fulfillment module receives a status update on an order item from a corresponding third party fulfiller, and, in response, automatically communicates the status update to a particular party requiring fulfillment of the order.

42. (Withdrawn) An improved e-commerce system for providing products and services of third parties, said system comprising:

a computer implemented program logic to present items to a user for on-line commerce;

computer-implemented program logic for receiving information requests regarding certain graphic images from the item presentation program logic, and providing digital images for display;

computer-implemented program logic for processing orders for graphic images; and

computer-implemented program logic for managing fulfillment of orders from one or more third party fulfillers.

43. (Withdrawn) The system of claim 42, wherein the computer-implemented program logic for processing orders automatically validates each order.

44. (Withdrawn) The system of claim 42, wherein the computer-implemented program logic for processing orders automatically checks availability of the graphic images.

45. (Withdrawn) The system of claim 42, wherein the computer-implemented program logic for processing orders automatically determines a source of supply of each graphic image.

46. (Withdrawn) The system of claim 42, wherein the computer-implemented program logic for processing orders automatically obtains digital copies of the appropriate graphic images after receiving orders for said graphic images.

47. (Withdrawn) The system of claim 42, wherein the computer-implemented program logic for processing orders packages digital copies of graphic images together with an order for those particular graphic images, and automatically routes the order and digital copies of the graphic images to a third party fulfiller for fulfillment.

48. (Withdrawn) The system of claim 42, wherein the computer-implemented program logic for processing orders automatically splits an order including individual graphic images from more than one third party fulfiller, and assigns fulfillment of individual order items to one or more appropriate third party fulfillers.

49. (Withdrawn) The system of claim 42, wherein the computer-implemented program logic for processing orders splits orders including items from the retailer and

items from one or more third parties fulfillers amongst the retailer and the appropriate third party fulfillers.

50. (Withdrawn) The system of claim 42, wherein the fulfillment module automatically routes each order for graphic images to be supplied by a third party fulfiller to an appropriate third party fulfiller.

51. (Withdrawn) The system of claim 42, wherein the order engine module automatically determines a source of fulfillment of each graphic image.

52. (Withdrawn) The system of claim 42, wherein the computer-implemented program logic for managing fulfillment of orders automatically requests a status update regarding individual order items comprising a pending order.

53. (Withdrawn) The system of claim 42, wherein the computer-implemented program logic for managing fulfillment of orders receives a status update on an order item from a third party fulfiller and automatically communicates the status update to a particular party requiring fulfillment of the order.

54. (Withdrawn) A system comprising:
a tagging logic to identify one or more items of a third party with unique identifiers, each unique identifier associated with data about that item;
an e-commerce logic to present at least some of the items to a user for on-line commerce;
an XML request logic to retrieve the data about the one or more items from a third party website, and enabling the e-commerce logic to present the data to the user for the on-line commerce; and
an order engine to process orders for items; and
a fulfillment module to automate fulfillment of pending orders from one or more third party fulfillers.

55. (Withdrawn) The apparatus of claim 54, wherein the data is image data.
56. (Withdrawn) The apparatus of claim 54, wherein the items include products.
57. (Withdrawn) The apparatus of claim 54, wherein the items include services.
58. (Previously Presented) A system providing an improved method for an e-commerce retailer to display and sell items of a third party, said system comprising:
- an e-commerce retailer to identify an item of a third party with a unique identifier;
 - an image server module for receiving information requests from the e-commerce retailer regarding certain items, and transparently providing images and descriptions of said items without an indication the items are third party items; and
 - an order engine module, in communication with said image server module, for processing orders for items.
59. (Previously Presented) The system of claim 58, wherein the items include products.
60. (Previously Presented) The system of claim 58, wherein the items include services.
61. (Previously Presented) The system of claim 58, wherein the items include graphic images corresponding to photo-finishing services offered to a user, at least some graphic images being based on photographs previously taken by the user.

62. (Cancelled)

63. (Cancelled)

64. (Previously Presented) The system of claim 58, wherein the order engine module automatically determines an appropriate third party fulfiller for each item.

65. (Previously Presented) The system of claim 58, wherein the order engine module:

automatically splits an order among more than one third party; and

automatically assigns fulfillment of individual order items to one or more appropriate third parties.

66. (Previously Presented) The system of claim 58, wherein the order engine module splits orders including items from the retailer and items from one or more third parties fulfillers amongst the retailer and appropriate third party fulfillers.

67. (Previously Presented) An improved e-commerce system for providing products and services of third parties, said system comprising:

a computer implemented program logic to transparently present third party items to a user for on-line commerce;

computer-implemented program logic for receiving information requests regarding certain graphic images from an item presentation program logic, and providing digital images for display; and

computer-implemented program logic for processing orders for graphic images to be transparently sent to the appropriate third party.

68. – 72. (Cancelled)

73. (Previously Presented) The system of claim 67, wherein the computer-implemented program logic for processing orders packages digital copies of graphic images together with an order for those particular graphic images, and automatically routes the order and digital copies of the graphic images to a third party fulfiller.

74. (Previously Presented) The system of claim 67, wherein the computer-implemented program logic for processing orders automatically splits an order including individual graphic images from more than one third party fulfiller, and assigns fulfillment of individual order items to one or more appropriate third party fulfillers.

75. (Previously Presented) The system of claim 67, wherein the computer-implemented program logic for processing orders splits orders including items from the retailer and items from one or more third parties fulfillers amongst the retailer and the appropriate third party fulfillers.

76. (Previously Presented) The system of claim 67, wherein the order engine module automatically determines a source of fulfillment of each graphic image.

77. (Previously Presented) A system comprising:

- a tagging logic to identify one or more items of a third party with unique identifiers, each unique identifier associated with data about that item;
- an e-commerce logic to transparently present at least some of the items to a user for on-line commerce;
- an XML request logic to retrieve the data about the one or more items from a

third party website, and enabling the e-commerce logic to present the data to the user for the on-line commerce; and

an order engine to process orders for items.

78. (Previously Presented) The apparatus of claim 76, wherein the data is image data.

79. (Previously Presented) The apparatus of claim 76, wherein the items include products.

80. (Previously Presented) The apparatus of claim 76, wherein the items include services.

CLAIMS APPENDIX (B)

FOR APPEAL BRIEF UNDER 37 C.F.R. § 41.37(c)(1)(viii)

Claims 1-19, 58-61, 64-67, and 73-39 are the subject of this appeal. A copy of Claims 1-19, 58-61, 64-67, and 73-39, as they stand on appeal, are presented above in Claims Appendix (A). The Appellants have included the claims as submitted in response to the Final Rejection (mailed May 3, 2006) that would have changed only a few words and removed matter which the Examiner argued was new matter.

1. (Currently Amended) An improved method for an e-commerce retailer to display and sell items of a third party comprising:
 - identifying one or more items of a third party supplier with a unique identifier;
 - associating the unique identifier of the item with an image of the item, said image residing on a computer maintained by the third party supplier;
 - presenting at least some of the images of third party supplier items to a user for on-line commerce, without indicating the items are third party items, said images being retrieved from said computer maintained by the third party supplier;
 - in response to an order request from the user for one or more items, identifying, based at least in part on said unique identifier, each item requested and an appropriate third party supplier for each requested item;
 - automatically generating an order for each requested item to be transparently sent to the third party supplier.

2. (Original) The method of claim 1, wherein the items include products.

3. (Original) The method of claim 1, wherein the items include services.
4. (Original) The method of claim 1, wherein the images of items include graphic images.
5. (Original) The method of claim 1, wherein the images of items include descriptive text.
6. (Original) The method of claim 1, wherein a given unique identifier references a corresponding product Stock Keeping Unit (SKU) numbers.
7. (Original) The method of claim 1, wherein a given unique identifier references pricing information from a third party.
8. (Original) The method of claim 1, wherein a given unique identifier references order fulfillment information.
9. (Currently Amended) The method of claim 1, wherein said step of presenting includes:
 - requesting images from a third party supplier;
 - receiving a list of Uniform Resource Locators (URLs) for said requested images;
 - and
 - displaying an on-line page that displays images retrieved from said URLs.
10. (Currently Amended) The method of claim 9, wherein the request for images includes background and formatting information of a particular third party supplier.

11. (Currently Amended) The method of claim 1, wherein a particular third party supplier provides photo-finishing services and the images correspond to user photographic images.

12. (Currently Amended) The method of claim 1, wherein a given third party supplier provides Uniform Resource Locators (URLs) for images in various sizes and formats, thereby enabling retrieval and display of images to the user in various sizes and formats.

13. (Currently Amended) The method of claim 1, wherein a given third party supplier initially provides smaller thumbnail images of the items and provides larger images in response to user requests.

14. (Currently Amended) The method of claim 1, wherein a given third party supplier evaluates the request for images or descriptions and automatically indicates whether corresponding items are available.

15. (Original) The method of claim 1, wherein the unique identifier associated with a given item is stored in a user's shopping cart when the user selects the item.

16. (Original) The method of claim 1, wherein the images are rendered on a Web page for display to the user.

17. (Currently Amended) The method of claim 1, wherein the unique identifier of an item requested by the user is employed for placing a fulfillment request with a corresponding third party supplier.

18. (Currently Amended) The method of claim 1, further comprising:
automatically splitting an order including individual order items from more than
one third party suppliers; and
assigning fulfillment of individual order items to the appropriate third party
suppliers parties.

19. (Currently Amended) The method of claim 1, wherein an order including items
from the retailer and items from one or more third party suppliers parties is split
amongst the retailer and the appropriate third party suppliers parties.

20.– 57. (Cancelled)

58. (Currently Amended) A system providing an improved method for an e-
commerce retailer to display and sell items of a third party, said system comprising:
an e-commerce retailer to identify an item of a third party supplier with a unique
identifier;
an image server module for receiving user information requests from the e-
commerce retailer regarding certain third party supplier items, and transparently
providing images and descriptions of said items without an indication the items are third
party items; and
an order engine module, in communication with said image server module, for
processing orders for third party supplier items.

59. (Previously Presented) The system of claim 58, wherein the items include
products.

60. (Previously Presented) The system of claim 58, wherein the items include services.

61. (Previously Presented) The system of claim 58, wherein the items include graphic images corresponding to photo-finishing services offered to a user, at least some graphic images being based on photographs previously taken by the user.

62. (Cancelled)

63. (Cancelled)

64. (Previously Presented) The system of claim 58, wherein the order engine module automatically determines an appropriate third party fulfiller for each item.

65. (Currently Amended) The system of claim 58, wherein the order engine module:

automatically splits an order among more than one third party suppliers; and
automatically assigns fulfillment of individual order items to one or more appropriate third party suppliers parties.

66. (Previously Presented) The system of claim 58, wherein the order engine module splits orders including items from the retailer and items from one or more third parties fulfillers amongst the retailer and appropriate third party fulfillers.

67. (Currently Amended) An improved e-commerce system for providing products and services of third parties, said system comprising:

a computer implemented program logic to transparently present third party supplier items to a user for on-line commerce;

computer-implemented program logic for receiving user information requests regarding certain graphic images from an item presentation program logic, and providing digital images for display; and

computer-implemented program logic for processing orders for graphic images to be transparently sent to the appropriate third party supplier.

68. – 72. (Cancelled)

73. (Previously Presented) The system of claim 67, wherein the computer-implemented program logic for processing orders automatically splits an order including individual graphic images from more than one third party fulfiller, and assigns fulfillment of individual order items to one or more appropriate third party fulfillers.

74. (Previously Presented) The system of claim 67, wherein the computer-implemented program logic for processing orders splits orders including items from the retailer and items from one or more third parties fulfillers amongst the retailer and the appropriate third party fulfillers.

75. (Previously Presented) The system of claim 67, wherein the order engine module automatically determines a source of fulfillment of each graphic image.

76. (Currently Amended) A system comprising:

a tagging logic to identify one or more items of a third party supplier with unique identifiers, each unique identifier associated with data about that item;

an e-commerce logic to transparently present at least some of the items to a user for on-line commerce;

an XML request logic to retrieve the data about the one or more items from a third party supplier website, and enabling the e-commerce logic to present the data to the user for the on-line commerce; and

an order engine to process orders for items.

77. (Previously Presented) The apparatus of claim 76, wherein the data is image data.

78. (Previously Presented) The apparatus of claim 76, wherein the items include products.

79. (Previously Presented) The apparatus of claim 76, wherein the items include services.

EVIDENCE APPENDIX

FOR APPEAL BRIEF UNDER 37 C.F.R. § 41.37(c)(1)(ix)

No evidence has been submitted with the pending Appeal.

RELATED PROCEEDINGS APPENDIX
FOR APPEAL BRIEF UNDER 37 C.F.R. § 41.37(c)(1)(x)

To the best of Appellant's knowledge, there are no appeals or interferences related to the present appeal that will directly affect, be directly affected by, or have a bearing on the Board's decision in the instant appeal.